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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,390	11/20/2003	Ronald F. Palermo	10670013010202	9732
37211	7590	11/02/2006		EXAMINER
BASCH & NICKERSON LLP				WOLLSCHLAGER, JEFFREY MICHAEL
1777 PENFIELD ROAD				
PENFIELD, NY 14526			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/718,390	PALERMO ET AL.
	Examiner	Art Unit
	Jeff Wollschlager	1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 August 2006.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

Applicant's amendment to the claims filed August 18, 2006 has been entered.

Claims 1, 8, 11, and 14 are currently amended. Claims 14-19 remain withdrawn from further consideration as being drawn to a non-elected invention. Claims 1-13 are under examination.

***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-13 in the reply filed on August 18, 2006 is acknowledged. The traversal is on the ground(s) that the examiner has not met the burden of showing that the product claimed can be made by another and materially different process. This is not found persuasive because the specifics to examine a process, namely the stepwise claim limitations and the material undergoing a change in physical or chemical state are not required when examining products, which are limited only by structural limitations. Although a process claim may contain apparatus or article limitations, they are only given patentable weight as to how the structure affects the stepwise process. Similarly, the specifics of an apparatus or article do not require the same consideration of stepwise process limitations as in a process claim, but rather only that the structure is capable of performing or being produced by such a process step. It is noted that the product of claim 14 is not necessarily floated or polished. It is further noted that the product of claim 14 does not require the aggregate be initially disbursed only over the surface of the concrete while it is semi-stiff. It also

appears to be applicant's position that the sequence by which the process steps are performed is considered to be a distinguishing characteristic of the process. It is noted that the product of claim 14 could be produced by a process comprising the same steps in a different sequence.

The requirement is still deemed proper and is therefore made FINAL.

Claims 14-19 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 103***

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Patent 6,033,146; issued March 7, 2000) in view of Danielsson (U.S. Patent 4,281,496; issued August 4, 1981).

Regarding claim 1, Shaw et al. teach a method for forming a decorative concrete material with integrated aggregate comprising the steps: Preparing and forming the region upon which the monolithic concrete floor is to be poured (col. 3, lines 31-33); contiguously pouring concrete throughout the formed region (col. 3 lines 42-45); striking off and floating the concrete to effectively densify the concrete (col. 3, lines 53-55 and 57-60); implicitly allowing the concrete to cure to a semi-stiff state because the concrete is intrinsically semi-stiff as evidenced by col. 4, lines 14-16 and due to the fact that time has passed since the completion of the floating step. Next, to the finished, generally planar surface, a quantity of decorative aggregate is disbursed over the semi-

stiff concrete surface (col. 3, line 65 – col. 4, line 5) and is then integrated into the upper surface of the semi-stiff concrete (col. 4, line 17-19). The concrete with the integrated aggregate is then partially cured (col. 4, lines 27-30), and the surface is washed and brushed such that no more than five percent of the particulates are removed (col. 4, lines 36-50). The concrete is then fully cured and washed and undergoes additional grinding and is polished (col. 4, lines 55-65) to provide a generally planar and smooth monolithic concrete floor.

Shaw et al. do not perform a traditional grinding step until after the floor has fully cured. However, Danielsson teaches an analogous method for forming a concrete floor where the grinding is performed after the floor is hardened/partially cured, but prior to the floor being fully cured to produce a floor comprising uniformly exposed aggregate over the top of the concrete (Abstract; col. 1, lines 56-64; col. 2, lines 17-22; col. 3, lines 46-52; col. 6, lines 47-52; col. 7, line 64 – col. 8, lines 11-19).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to perform the grinding step disclosed by Shaw et al. before the floor was fully cured as taught by Danielsson, for the purpose as taught by Danielsson, of improving the efficiency of the grinding step (col. 8, lines 11-19)

As to claim 2, Shaw et al. teach the aggregate particulate is approximately 3/8", which is approximately 9 mm (col. 4, line 5).

As to claims 3-5, Shaw et al. teach the aggregate comprises naturally occurring materials such as seashells and various metals as well as man-made materials such as glass and composite materials (col. 4, lines 1-5).

As to claim 6, Shaw et al. do not explicitly state that the semi-stiff state is determined by a one-quarter inch depression resulting from an applied normal force of between about 4 and 5 pounds per square inch. However, Shaw et al. teach a semi-stiff state of the concrete such that the particulate is prevented from impressing into the surface of the concrete before it is so desired (col. 4, lines 14-16). Whereas Shaw et al. employ the same claimed material in the same claimed way under the same claimed process conditions it follows that the semi-stiff state disclosed by Shaw et al. is the same as the semi-stiff state recited in the claim. It is further noted that the claim does not appear to define a manipulative step.

As to claim 7, Shaw et al. teach the concrete may be colored (col. 3, line 50).

As to claims 8-10, Shaw et al. teach that the top surface may be treated with a hydrolyzed alkali silica solution sealer after the floor is completed which results in the formation of an insoluble silicate structure on the surface of the concrete (col. 4, line 65 – col. 5, line 15).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Patent 6,033,146; issued March 7, 2000) in view of Danielsson (U.S. Patent 4,281,496; issued August 4, 1981), as applied to claims 1-10 above, and further in view of Chiuminatta et al.

As to claim 13, Shaw et al. in view of Danielsson teach the method of claim 1 as discussed in the 103(a) rejection above. Shaw et al. is silent about the conventional practice of scoring the semi-cured floor to facilitate stress relief. However, Chiuminatta et al. provide explicit teaching where a diamond saw is employed to score a semi-cured concrete floor (Abstract; col. 1, lines 49-63; col. 3, lines 8-15; col. 5, lines 36-38).

Therefore it would have been *prima facie* obvious to employ the scoring technique disclosed by Chiuminatta et al. while practicing the method of Shaw et al. for the purpose of facilitating uniform stress relief such that the provided expansion or contraction joints prevent the concrete from cracking undesirably

Claims 1, 3-5, 6, and 13 are rejected under 35 U.S.C. 103(a) as being obvious over Phillips (U.S. Patent 5,441,677; issued August 15, 1995).

Regarding claim 1, Phillips teaches a method of making a high gloss concrete floor comprising preparing the base upon which the concrete is to be poured ((20); col. 3, lines 51-53); pouring the concrete ((24); col. 3, lines 53-54); floating the rough concrete and subsequently applying dry shake/aggregate over the surface. Then the floor is finished by floating and the process of applying dry shake/aggregate which effectively integrates the aggregate into the upper surface of the concrete is repeated. The floating and dry shake addition is repeated until the surface is firm enough to support a finishing blade (col. 3, lines 54-col. 4, line 4). It is noted that by repeating the additional process steps not recited in the instant claim that the claimed process steps are completed in order at different stages of the repetitious process.

The floor is partially cured and is then ground to establish the desired surface smoothness (col. 4, lines 40-48). After further curing the floor is polished just prior to the anticipated use of the floor (col. 4, lines 56-59 and col. 6, lines 15-63; col. 7, lines 6-56) and is maintained by future resurfacing/polishing (col. 8, lines 5-8). It is noted that changing the sequence in which process steps are completed has been held to be *prima facie* obvious absent unexpected or new results.

As to claims 3-5, the dry shake aggregate employed by Phillips is a manufactured object/material containing man made material and naturally occurring material (col. 3, lines 51-65).

As to claim 6, Phillips does not explicitly state that the semi-stiff state is determined by a one-quarter inch depression resulting from an applied normal force of between about 4 and 5 pounds per square inch. However, Phillips teaches a semi-stiff state of the concrete such that the particulate is prevented from impressing into the surface of the concrete before it is so desired (col. 4, lines 14-16). Whereas Phillips employ the same claimed material in the same claimed way under the same claimed process conditions it follows that the semi-stiff state disclosed by Phillips is the same as the semi-stiff state recited in the claim. It is further noted that the claim does not appear to define a manipulative step.

As to claim 13, Phillips teaches employment of a conventional concrete saw (col. 6, line 68 – col. 7, line 5).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (U.S. Patent 5,441,677; issued August 15, 1995), as applied to claims 1, 3-5, 6, and 13 above, in view of Surface Preparation (IDS document, 2001)

As to claim 11, Phillips teaches that the grinding step employs progressively finer sanding/silicon carbide screens until the desired smoothness is achieved (col. 4, lines 40-49) but does not disclose employment of diamond disks. However, the Surface Preparation document illustrates the employment of diamond disks for grinding concrete (page 3 and 6 of the document). Further, it is noted that one having ordinary skill would have been motivated to optimize the different grit and types of sandpaper depending on the type of aggregate used, the degree of concrete cure, and the ultimately desired surface texture and shine of the product as is routinely practice in the art and as suggested by Phillips (col. 4, lines 40-49).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (U.S. Patent 5,441,677; issued August 15, 1995) in view of Surface Preparation (IDS document, 2001), as applied to claim 11 above, and further in view of Jones (U.S. Patent 6,454,632; issued September 24, 2002).

As to claim 12, Phillips in view of Surface Preparation suggest the method of claim 11 above, but do not teach the limitations of claim 12. However, Jones et al. teach applying a surface treatment to the polished upper surface, where the surface treatment is a chemical reactive concrete stabilizer providing a densified upper surface (Abstract; col. 2, lines 50 – col. 3, line 25).

Therefore it would have been *prima facie* obvious to one having ordinary skill to employ the surface treatment disclosed by Jones et al. in the method taught by Phillips for the purpose, as taught by Jones et al. of hardening/densifying and polishing a concrete surface (Abstract).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection necessitated by applicant's amendment to the claims.

The examiner notes that Chiuminatta et al. (U.S. Patent 5,086,750) was cited on form PTO-892 as a part of the previous office action. As requested by applicant, the reference has been applied to the rejection of claim 13.

### ***Conclusion***

All claims are rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW  
Jeff Wollschlager  
Examiner  
Art Unit 1732

October 26, 2006

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10/30/00